

Serial No. 10/791,088  
Atty. Doc. No. 2002P18158US

REMARKS

Claims 1, 3-7, 9, 11, 13 and 14 are pending in this application. Claim 3 is objected to under 37 CFR 1.75(c) for being of improper dependent form. Claims 1, 3-7, 9, 11, 13 and 14 are rejected under 35 USC 112, first paragraph, as failing to comply with the written description requirement. Claims 1, 3-7, 9, 11, 13 and 14 are rejected under 35 USC 112, second paragraph, as being indefinite because of the use of a negative limitation. Claims 1, 3-7, 9, 11, 13 and 14 are rejected under 35 USC 102(b) as being anticipated by Warren.

Applicants have amended claims 1, 3, 7, and 11. Applicants respectfully request entry of this amendment and reconsideration and allowance of the pending claims in view of the foregoing amendments and the following remarks.

Response to Objection to Claim 3:

Claim 3 has been amended to depend from claim 1, thereby overcoming the objection under 37 CFR 1.75(c).

Response to Rejection Under Section 112, first paragraph:

The applicants traverse the rejection of claims 1, 3-7, 9, 11, 13 and 14 under 35 USC 112, first paragraph. The Examiner states that the negative limitation "without using a separate external line for supply of cooling steam" does not have basis in the original disclosure. The Examiner's attention is drawn to page 2, lines 24-25, and page 3, line 35 of the English translation of the specification (paragraphs 0007 and 0012 of the Substitute Specification) where the cited limitation is taught in the original disclosure. Accordingly, reconsideration and withdrawal of the rejections under 35 USC 112, first paragraph, are respectfully requested.

Response to Rejection Under Section 112, second paragraph:

The Examiner states that the negative limitation "without using a separate external line for supply of cooling steam" is an attempt to claim the invention by excluding what the inventors did not invent rather than distinctly and particularly pointing out what they did invent. The applicants traverse this rejection as follows.

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First, the negative language in question has been deleted from independent claims 1 and 11, thereby rendering moot this rejection as to claims 1, 3-6, 11 and 13-14.

As to claims 7 and 9, the applicants submit that there is nothing inherently ambiguous or uncertain about the negative limitation in question. As explained in MPEP 2173.05(i), negative claim language has been accepted by the courts under 35 USC 12, second paragraph, so long as the boundaries of the patent protection sought are set forth definitely. Claim 7 clearly describes the source of the steam as being the "live-steam feed line having a branch with which part of the flow medium is passed via a line to a heat exchanger within an exhaust region of the turbo machine." There is nothing ambiguous or uncertain about the source of the cooling steam. The negative limitation simply further limits this already definite claim language. Thus, the boundaries of the patent protection sought are clear, placing the present claim language within the scope of *In re Barr*, 444 F.2d 588, 170 USPQ 330 (CCPA 1971) where the court found that a negative limitation was definite.

The negative limitation has been amended herein in independent claim 7 to further specify: "without using a separate external line for supply of cooling steam from a source other than the live-steam feed line." This additional limitation further clarifies and makes even more certain the intention of the negative limitation and the scope of claims 7 and 9.

Accordingly, reconsideration and withdrawal of the rejections under 35 USC 112, second paragraph, as respectfully requested.

Response to Rejection Under Section 102(b):

Claims 1, 3-7, 9, 11 and 13-14 are rejected as being anticipated by Warren. MPEP §2131 provides that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. The identical invention must be shown in as complete detail as contained in the claim. The elements must be arranged as required by the claim.

Each of the independent claims 1, 7 and 11 has been amended to clarify that the exhaust region of the turbo machine within which the heat exchanger is disposed is defined by a housing of the turbo machine. Warren teaches away from this limitation by describing the placement of a heat exchanger in a downstream location from the turbo machine within a cross-over pipe

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between the turbo machine and a downstream reheater. The present invention improves upon that prior art arrangement by placing the heat exchanger in a location wherein the length of associated piping is minimized such that the cooling steam is virtually generated by the turbo machine itself. (see English translation specification page 2, lines 31-32 and page 3, lines 36-37)

Accordingly, Warren does not support the rejection under 35 USC 102, and reconsideration and withdrawal of the rejection under 35 USC 102 is respectfully requested.

Conclusion

For the foregoing reasons, it is respectfully submitted that the rejections set forth in the outstanding Office Action have been overcome and that the application is now placed into condition for allowance by the amendments and remarks provided herein. In the alternative, the present amendments place the claims in better condition for appeal, and thus, entry of this amendment after final rejection is respectfully requested.

Please grant any extensions of time required to enter this paper. The commissioner is hereby authorized to charge any appropriate fees due in connection with this paper, or credit any overpayments to Deposit Account No. 19-2179.

Respectfully submitted,

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